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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,799	05/21/2007	Jeffery W. Finch	W-362-02	1516

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Waters Technologies Corporation
34 MAPLE STREET - LG
MILFORD, MA 01757

EXAMINER

SMITH, JOHNNIE L

ART UNIT	PAPER NUMBER
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2881

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01/20/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/598,799	Applicant(s) FINCH ET AL.	
	Examiner JOHNNIE L. SMITH	Art Unit 2881	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/21/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 17-20, 22 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 1, 17-20, 22 and 28 recite the limitation “wherein said second capillary is disposed partially within said second capillary”. There is insufficient antecedent basis for this limitation in the claim. The said limitation is unclear.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6 and 12-29 are rejected under 35 U.S.C. 102(b) as being anticipated by US 20020150511 (Wiktor).
6. In reference to claims 1, 17-20, 22 and 28, to the extent taught and understood, Wiktor discloses a capillary column (11), having a column, a first

capillary (19e) and a second capillary (12, 12e), wherein said second capillary is securely positioned within said first capillary (figure 2) using an adhesive agent (paragraph 0050 lines 10-13 via 59e), and wherein a portion of said second capillary protrudes from said first capillary (see figure 2).

7. In reference to claims 2 and 23, Wiktor teaches the said first capillary comprises a material selected from the group consisting of polyimide-coated fused silica or the like (paragraph 0047 line 1).

8. In reference to claims 3 and 24, Wiktor teaches the said second capillary comprises a material selected from the group consisting of fused silica or the like (paragraph 0047).

9. In reference to claims 4 and 25, Wiktor teaches the said first and said second capillaries comprise polyimide-coated fused silica (paragraph 0047 line 1).

10. In reference to claims 5, 26 and 29, Wiktor teaches the said adhesive agent is a low viscosity adhesive (paragraph 0050 lines 10-13).

11. In reference to claims 6 and 27, Wiktor teaches the said second capillary protrudes from said first capillary by approximately 9.5 mm (paragraph 0047 lines 1-6).

12. In reference to claims 12-16, Wiktor teaches the capillary column including the said first and said second capillaries comprising a coating material (paragraph 0006 polyimide).

13. In reference to claim 21, the limitation of having a mass spectrometer as the desired detection system is considered inherent.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiktor (cited and discussed above).

17. In reference to claims 7-11, applicant discloses having various inner and outer diameters for the said first and second capillary within the claimed column.

Wiktor fails to clearly teach having the claimed specific diameters as being claimed by applicant.

18. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have such diameters, since it has been held by the courts that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device, and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

19. It should be noted that Wiktor discloses that is known in the art to manufacture glass capillaries having tight tolerance. One would be compelled to have the claimed diameters since this feature makes them useful for accurate sampling and diagnosis purposes.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

21. All of the references cited on attached PTO 892 contain art similar to that being claimed by applicant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHNNIE L. SMITH whose telephone number is (571)272-2481. The examiner can normally be reached on Monday-Thursday 6-4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Kim can be reached on 571.272.2293. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JOHNNIE L SMITH II

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Examiner
Art Unit 2881

/J. L. S./
Examiner, Art Unit 2881

/ROBERT KIM/
Supervisory Patent Examiner, Art Unit 2881